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SHARON SHULTON
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Sharon Shulton
(Signature)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

Applicant : Gauthier, Forrest P.
Serial No. : 10/707,955
Filed : January 28, 2004
Title : METHOD OF UTILIZING VARIABLE DATA FIELDS WITH A PAGE DESCRIPTION LANGUAGE
Docket No. : TES04-GN002-C4
Examiner :
Art Unit :

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

INFORMATION DISCLOSURE STATEMENT

Pursuant to 37 C.F.R. § 1.97, the Examiner's attention is directed herein to the following disclosure along with the copies of the foreign references cited in Form PTO/SB/08A and the publication references cited in Form PTO/SB/08B.

Background

Pursuant to a patent infringement suit (Civil No. C-1-99-336) filed on May 25, 1999, by Varis Corporation against Scitex Digital Printing, Inc., Applicant became aware of allegations of

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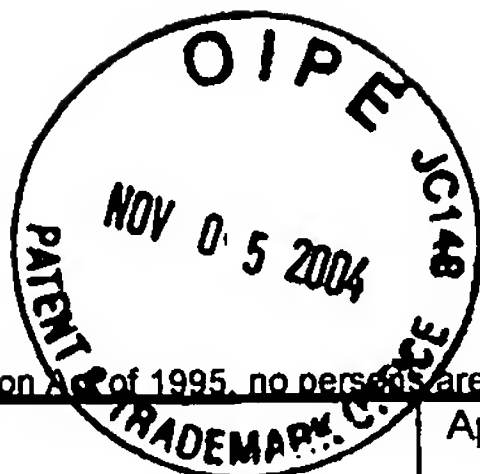
A fee of \$180.00 is required. The Commissioner is hereby authorized to charge any fees which may be required by this paper, or to credit any overpayment to Deposit Account 50-3072.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'David A. Mancino', written over the typed name.

David A. Mancino
Reg. No. 39,289

030074
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IFW

PTO/SB/21 (09-04)

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FORM**

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Total Number of Pages in This Submission

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Application Number

10/707,955

Filing Date

01-28-2004

First Named Inventor

Gauthier, Forrest P.

Art Unit

Examiner Name

Attorney Docket Number

TES05-GN002-C4

ENCLOSURES (Check all that apply)☐

Fee Transmittal Form

☐

Fee Attached

☐

Amendment/Reply

☐

After Final

☐

Affidavits/declaration(s)

☐

Extension of Time Request

☐

Express Abandonment Request

☒

Information Disclosure Statement

☐

Certified Copy of Priority Document(s)

☐Reply to Missing Parts/
Incomplete Application☐Reply to Missing Parts
under 37 CFR 1.52 or 1.53☐

Drawing(s)

☐

Licensing-related Papers

☐

Petition

☐Petition to Convert to a
Provisional Application☐Power of Attorney, Revocation
Change of Correspondence Address☐

Terminal Disclaimer

☐

Request for Refund

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CD, Number of CD(s) _____

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Landscape Table on CD

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After Allowance Communication to TC

☐Appeal Communication to Board
of Appeals and Interferences☐Appeal Communication to TC
(Appeal Notice, Brief, Reply Brief)☐

Proprietary Information

☐

Status Letter

☒Other Enclosure(s) (please identify
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Remarks

Information Disclosure Statement including Form PTO/SB/08A&B, with copies of cited references

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

Taft, Stettinius & Hollister LLP

Signature

Printed name

David A. Mancino

Date

11-02-2004

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Sharon A. Shelton, Paralegal

Date

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invalidity of United States Patent No. 5,729,665 (hereinafter the '665 patent). United States Patent Application No. 09/373,582, which issued as the '665 patent, is the parent application of the above-referenced pending application. The allegations were made during the discovery of the aforementioned suit, and Applicant believed at the time and continues to believe that the allegations proffered by Scitex's trial counsel are completely without merit. However, to remove any influence that Applicant is not fully meeting its duty of candor to the Office, Applicant is disclosing the following information, even though it is firmly believed that the disclosure of such has no bearing upon the patentability of the present pending matter.

As an update, Varis Corporation was the assignee of the '665 patent at the initiation of the relevant suit. Thereafter, the intellectual property assets of Varis Corporation were sold to the current assignee of the above-referenced pending application, Tesson, Ltd.

List of Allegations

Allegation of On-Sale Bar

Scitex's trial counsel alleged in his July 28, 1999, Answer to Complaint, that the '665 patent was invalid under 35 U.S.C. § 102.

In response to Scitex's Answer to Complaint, Varis Corporation's trial counsel requested Scitex answer a First Set of Interrogatories, dated September 1, 1999, of which no less than three interrogatories were directed to determining the aforementioned allegation of invalidity. On December 6, 1999, Scitex's counsel submitted a Response to the First Set of Interrogatories by

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alleging that the '665 patent was invalid under 35 U.S.C. § 102 as being invalid based upon public use and/or on sale activity by Applicant, without any further specification. Varis Corporation's counsel sent Scitex's counsel a Second Set of Interrogatories on January 12, 2000, that were directed solely to the invalidity claims. The Second Set of Interrogatories went unanswered by Scitex's counsel according to the records provided to Applicant's undersigned counsel.

Allegation of Anticipation or Obviousness

Scitex's trial counsel also alleged that the '665 patent was invalid under 35 U.S.C. § 102, 103 as being invalid based upon Scitex's "DijiComp" products and Monarch Marking Systems, Inc.'s label printing products that were publicly known before January 18, 1994.

In response to Scitex's Answer to the Complaint, Varis Corporation's trial counsel requested Scitex answer a First Set of Interrogatories, dated September 1, 1999, of which no less than three interrogatories were directed to determining the aforementioned allegation of invalidity. On December 6, 1999, Scitex's counsel submitted a Response to the First Set of Interrogatories by indicating that the '665 patent was invalid under 35 U.S.C. § 102 as being invalid based upon anticipation or obviousness, without any further specification. Varis Corporation's counsel sent Scitex's counsel a Second Set of Interrogatories on January 12, 2000, which were directed solely to the invalidity claims. The Second Set of Interrogatories went unanswered by Scitex's counsel according to the records provided to Applicant's undersigned counsel.

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As an additional note, Scitex's counsel subpoenaed Monarch Marking Systems, Inc., on November 11, 1999, to produce and permit inspection and copying of documents or objects pertaining to: (1) the model 9490 Renegade printer; (2) the model 9446 printer; (3) the MPCCL printer control language; (4) any printer or documents related to a printer capable of inserting variable data records of fields into a template of fixed data; and (5) documents related to saving a bitmap of a template print job. No information pertaining to the validity of the '665 patent appears from the record to ever have been produced or, if produced, was never made available to Varis Corporation or its counsel

Allegation of Written Description or Distinctly Claiming Failure

Scitex's trial counsel alleged that the '665 patent was invalid under 35 U.S.C. § 112 as being invalid based upon failing to meet the requirements of 35 U.S.C. § 112, ¶¶ 1 and/or 2.

In response to Scitex's Answer to Complaint, Varis Corporation's trial counsel did not request from Scitex more detailed information regarding the § 112 issues as the allegations were on their face clearly without merit.

Conclusion of the Suit

On February 13, 2002, Chief Judge Walter Herbert Rice of the United States District Court of the Southern District of Ohio issued a judgment dismissing Varis Corporation's

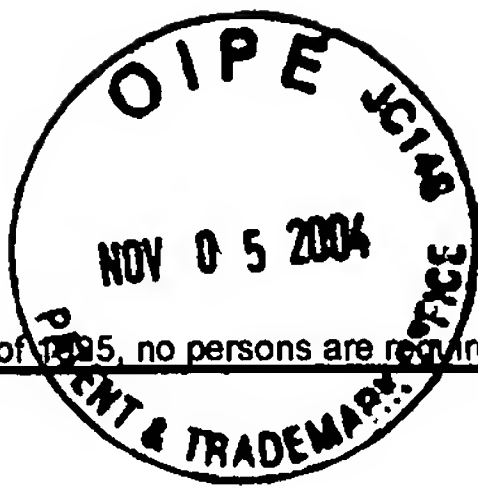
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complaint with prejudice for failure to prosecute its claims against Scitex Digital Printing, Inc. Judge Rice also refused to grant Scitex's default-judgment motion to declare the '665 patent invalid since Scitex did not present any evidence to the court supporting such allegations. (J.p.8).

Current Submission

Applicant is submitting two United States Patents assigned to Monarch Marking Systems, Inc., namely, U. S. Patents number 5,483,624 and 5,544,287. Said patents were found by the undersigned by performing an online search for patents related to Monarch Marking System's label printing products referenced by Scitex in the Varis v. Scitex lawsuit. Applicant respectfully submits that the two patents listed are not material to the patentability of the above-referenced application, nor are they material to the patentability of the '665 patent. Applicant submits that the references are being cited in a preemptive fashion so as to avoid any appearance of impropriety in procuring a patent from the above-referenced application.

It is to be understood that the present disclosure of art is in no way intended to be a waiver of any arguments or defenses available to the Applicant under the rules of the U.S. Patent and Trademark Office and the statutes of the United States.



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Sheet

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Application Number	10/707,955
Filing Date	01-28-2004
First Named Inventor	Gauthier, Forrest P.
Art Unit	
Examiner Name	
Attorney Docket Number	TES05-GN002-C4

U. S. PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code ² (if known)			
		US- 4,944,614	07-31-1990	Tanaka	
		US- 5,103,490	04-07-1992	McMillin	
		US- 5,134,669	07-28-1992	Keogh et al	
		US- 5,157,765	10-20-1992	Birk et al	
		US- 5,202,206	04-13-1993	Tam	
		US- 5,208,906	05-04-1993	Morgan	
		US- 5,222,235	06-22-1993	Potash et al	
		US- 5,231,698	07-27-1993	Forcier	
		US- 5,291,243	03-01-1994	Heckman et al	
		US- 5,459,819	10-17-1995	Watkins et al	
		US- 4,459,826	10-17-1995	Archibald	
		US- 5,467,448	11-14-1995	Hilton et al	
		US- 5,483,624	01-09-1996	Christopher et al	
		US- 5,500,928	03-19-1996	Cook et al	
		US- 5,506,697	04-09-1996	Li et al	
		US- 5,539,529	07-23-1996	Merchant	
		US- 5,542,052	07-30-1996	Deutsch et al	
		US- 5,544,287	08-06-1996	Roth	
		US- 5,600,768	02-04-1997	Andresen	

FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages Or Relevant Figures Appear	T ⁶
		Country Code ³ Number ⁴ Kind Code ⁵ (if known)				
		EP 0 703 524 B1	08-01-1997	Herregods et al		
		CA 2,207,840	12-18-1997	Desautels et al		
		CA 2,215,094	04-16-1998	Desautels et al		
		WO 98/081176	02-26-1998	Dorfman et al		

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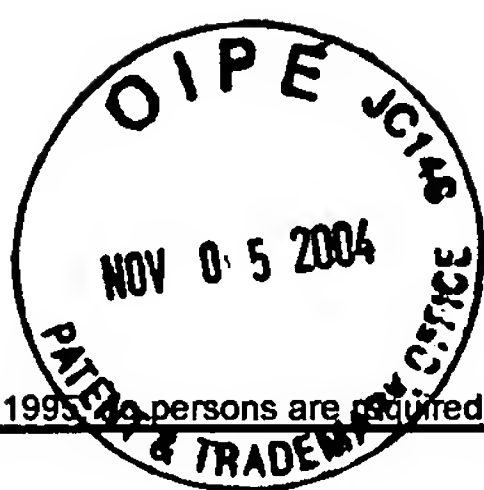
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		Number-Kind Code ² (if known)			
		US- 5,033,009	07-16-1991	Dubnoff	
		US- 5,611,024	03-11-1997	Campbell et al	
		US- 5,671,345	09-23-1997	Lhotak	
		US- 5,729,665	03-17-1998	Gauthier	
		US- 5,754,750	05-19-1998	Butterfield et al	
		US- 5,841,420	11-24-1998	Kaply et al	
		US- 5,926,185	07-20-1999	Vyncke et al	
		US- 5,960,164	09-28-1999	Dorfman et al	
		US- 6,064,397	05-16-2000	Herregods et al	
		US- 6,243,172	06-05-2001	Gauthier et al	
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Examiner Name	
Attorney Docket Number	TES05-GN002-C4

Sheet 3 of 3

NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
		IDG InfoWorld, October 9, 1995, Review, pg. 91, IDG Communications, Inc., U.S.A.	
		IDG InfoWorld, March 20, 1995, Product Reviews; Desktop publishing software; pg. 92, IDG Communications, Inc., U.S.A.	
		IDG InfoWorld, May 9, 1994, Reviews: pg. 98, IDG Communications, Inc., U.S.A.	

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